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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEYHAN KARAOGUZ and JAMES BENNETT

Appeal 2009-011859
Application 10/675,439
Technology Center 2400

Before ALLEN R. MacDONALD, DAVID M. KOHUT, and JASON V. MORGAN, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Introduction

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-31. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants' Abstract

> Certain embodiments of the invention may be found in a method and system for providing media in a communication network. In this regard, certain aspects of the method for providing media in a communication network may comprise receiving a media file at a first home via the communication network. The media file may be received from outside the first home and a first format for the received media file may be determined within the first home. Accordingly, the received media file may be converted from the first format to a second format that is *compatible with presenting and/or playing the converted media file on a television screen within the* ***first home***.

(Appellants' Spec. 40, ¶ [127])(emphasis added).

Exemplary Claim

Exemplary claim 1 under appeal reads as follows (emphasis added):

> Claim 1. A method for providing media in a communication network, the method comprising:
>
> receiving a media file from the communication network at a first home in a first geographic location, said media file received from outside said first home;
>
> determining within said first home, a first format of said received media file; and
>
> converting within said first home, said received media file from said first format to a second format *compatible for one or both of presentation and/or playback on a television screen within a* ***second home*** *in a second geographic location.*

Rejections[1]

The Examiner rejected claims 1-5, 7, 8, 10-15, 17, 18, 20-25, 27, 28, 30, and 31 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Dureau (US 2003/0135860 A1) and Lu (US 7,065,778 B1).

The Examiner rejected claims 6, 9, 16, 19, 26, and 29 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Dureau, Lu, and Kaars (US 2003/0066084 A1).

Appellants' Contentions

1. Appellants contend that the Examiner erred in rejecting claims 1, 11, and 21 under 35 U.S.C. § 103(a) because Lu does not overcome the "second location" deficiencies of Dureau. (App. Br. 8).

2. Appellants contend that the Examiner erred in rejecting claims 2, 12, and 22 under 35 U.S.C. § 103(a) because "Dureau clearly does not disclose or suggest decoding and/or decrypting of received media file within the first home, as recited by the Appellant in claim 2." (App. Br. 9-10).

3. Appellants contend that the Examiner erred in rejecting claims 3, 13, and 23 under 35 U.S.C. § 103(a) because "Dureau-Lu does not disclose or suggest at least the limitation of 'transcoding said received media file within said first home from said first format to said second format,' as recited by the Appellant in claim 3." Further, as explained with regard to claims 1, 11, and 21, "Dureau . . . does not disclose any format conversion for purposes of presentation/playback in a second location." (App. Br. 10-11).

[1] Separate patentability is not argued for claims 6, 9, 10, 16, 19, 20, 26, and 29-31.

4. Appellants contend that the Examiner erred in rejecting claims 4, 14, and 24 under 35 U.S.C. § 103(a) because "Dureau-Lu does not disclose or suggest at least the limitation of 'directly transferring said converted media file to at least one media peripheral located within said first home,' as recited by the Appellant in claim 4." Further, as explained with regard to claims 1, 11, and 21, "Dureau . . . does not disclose any format conversion for purposes of presentation/playback in a second location." (App. Br. 12).

5. Appellants contend that the Examiner erred in rejecting claims 5, 15, and 25 under 35 U.S.C. § 103(a) because "Dureau-Lu does not disclose or suggest at least the limitation of 'distributing said converted media file to one or both of a media peripheral within said first home and/or a media peripheral within said second home via one or both of a wired and/or a wireless connection,' as recited by the Appellant in claim 5." Further, as explained with regard to claims 1, 11, and 21, "Dureau . . . does not disclose any format conversion for purposes of presentation/playback in a second location." (App. Br. 13-14).

6. Appellants contend that the Examiner erred in rejecting claims 7, 17, and 27 under 35 U.S.C. § 103(a) because "Dureau-Lu does not disclose or suggest at least the limitation of 'storing said converted media file in one or both of a network attached storage and/or a storage area network within one or both of said first home and/or said second home,' as recited by the Appellant in claim 7." Further, as explained with regard to claims 1, 11, and 21, "Dureau . . . does not disclose any format conversion for purposes of presentation/playback in a second location." (App. Br. 15).

7. Appellants contend that the Examiner erred in rejecting claims 8, 18, and 28 under 35 U.S.C. § 103(a) because "Dureau-Lu does not disclose or suggest at least the limitation of 'retrieving said stored converted media file,' as recited by the Appellant in claim 8." Further, as explained with regard to claims 1, 11, and 21, "Dureau . . . does not disclose any format conversion for purposes of presentation/playback in a second location." (App. Br. 16-17).

Issue on Appeal

Did the Examiner err in rejecting claims 1-31 as being obvious because Lu does not overcome the "second location" deficiencies of Dureau?

FINDINGS OF FACT (FF)

1. Appellants state that as to their invention:

> Certain aspects of the invention may be found in a method and system for providing media in a communication network. Certain aspects of the method for providing media in a communication network may comprise receiving a media file at a first home via the communication network. The media file may be received from outside the first home and a first format for the received media file may be determined within the first home. Accordingly, *the received media file may be converted from the first format to a second format that is compatible with presenting and/or playing the converted media file on a television screen within the* ***first home***. The received media file may be audio, video, images, graphical and/or textual media.

(Appellants' Spec. 4, ¶ [12])(emphasis added).

2. Appellants go on to state as to their invention:

> The received media file may be decoded and/or decrypted within the first home or it may be transcoded from the first format to the second format that is compatible for presentation or display on the television screen within the first home. The converted media file may be directly transferred to one or more media peripherals that may be located within the first home. The converted media file may also be distributed or migrated to a media peripheral within the first home and/or a media peripheral within a second home via a wired and/or wireless connection. In this regard, authorization may be received prior to *distributing or migrating the converted media file to a media peripheral that is located at the* ***second home*** *or outside the second home.*

(Appellants' Spec. 4, ¶ [13])(emphasis added).

ANALYSIS

We have reviewed the Examiners' rejections in light of Appellants' arguments (Appeal Brief and Reply Brief) that the Examiner has erred.

We disagree with Appellants' conclusions. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusions reached by the Examiner.

Regarding above contention 1, Appellants fail to argue the rejection as set forth by the Examiner. We find Appellants' supposed deficiencies of the Dureau reference to be merely the differences from the claimed invention pointed out by the Examiner in the rejection. (Ans. 4). The Examiner's rejection then goes on to explain why the Lu reference, in Appellants words, overcomes those differences. (Ans. 4-5). Appellants' arguments allege that

Lu "does not overcome the . . . deficiencies of Dureau." (App. Br. 8). However, we find Appellants' Brief to be silent as to why this is the case. Appellants' silence does not persuade us that the Examiner has erred.

Regarding above contention 2, Appellants quote a claim limitation and allege that the prior art does not disclose or suggest the limitation. Appellants' Brief is otherwise silent as to why this is the case. Again, Appellants' silence does not persuade us that the Examiner has erred. Appellants present no substantive arguments regarding the claims other than merely restating the limitations called for in the claims. *See* 37 C.F.R. § 41.37(c)(1)(vii) ("A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim."); *In re Lovin*, 99 USPQ2d 1373, 1379 (Fed. Cir. 2011) ("[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.").

Regarding above contentions 3 through 7, Appellants quote a claim limitation and allege that the prior art does not disclose or suggest the limitation. Other than repeating the contention 1 argument directed to the "second location," Appellants' Brief is silent as to why the prior art does not disclose or suggest the quoted claim limitation. Appellants' contentions do not persuade us that the Examiner has erred.

Lastly, separately from our affirmance of the Examiner's rejection we also note that Appellants' written description as filed is silent as to the current claim limitation of converting, within said first home, a received media file from a first format to a second format compatible for one or both

of presentation and/or playback on a television screen within a ***second home in a second geographic location***. Rather, Appellants' written description, as filed, states throughout that the conversion is to a second format that is compatible with presenting and/or playing the converted media file on a television screen ***within the first home*** (*e.g.*, FF1 and Appellants' Abstract). The disclosures of functions at a second home are limited to distributing or migrating the converted media file to a media peripheral that is ***located at the second home*** or outside the second home (*e.g.*, FF2). Given the specific embodiment found in Appellants' written description as originally filed, it is clear that Appellants' shift of the originally filed claim from "presentation and playback on a television screen within said first home" to "presentation and/or playback on a television screen within a second home in a second geographic location" must be premised on the fact that the disclosure of presentation and playback on a television screen within a first home is by itself sufficient to disclose to an artisan the same functions at a second location. As such, we conclude that Appellants' argument that the Examiner has erred in finding claims 1-31 to be obvious over the disclosures of Dureau and Lu, is contradicted by Appellants' own reliance on their written description as filed as sufficient basis for the claims before us.

CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 1-31 as being unpatentable under 35 U.S.C. § 103(a).

(2) Claims 1-31 are not patentable.

DECISION

The Examiner's rejections of claims 1-31 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

msc